

REMARKS

Upon entry of the present amendment, claims 1, 2, 4, 5, 7, 14, and 15 will have been amended, while claims 6, 8-13, 17, 19, and 20 will have been canceled.

In view of the herein contained amendments and remarks, Applicants respectfully request reconsideration and withdrawal of each of the outstanding objections and rejections set forth in the above-mentioned Official Action, together with an indication of the allowability of all of the claims pending in the present application.

Applicants note with appreciation the Examiner's consideration of the documents cited in the Information Disclosure Statement filed in the present application by the return of the initialed and signed copy of the PTO-1449 Form accompanying the Information Disclosure Statement filed herein.

Applicants further note with appreciation the Examiner's acknowledgment of Applicants' claim for foreign priority under 35 U.S.C. § 119 and the filing of the certified copies of the priority documents in the parent application.

Finally, Applicants note with appreciation the Examiner's indication that claims 6 and 17 would be allowable if rewritten in independent form, if rewritten to overcome the 35 U.S.C. § 112, second paragraph rejection, and if the obviousness-type double patenting rejection is overcome.

Initially, the Examiner has objected to the drawings as requiring a “prior art” legend. In response to the Examiner’s objection, Applicants have attached sheets of drawings that include the addition of a legend to figures 11-20 as required by the Examiner.

The Examiner has rejected claims 1-20 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

With respect to the 35 U.S.C. § 112, second paragraph, rejection of claims 1 and 14, Applicants do not necessarily agree with the Examiner’s rejection, however Applicants have amended these claims in order to expedite prosecution. In this regard claims 1 and 14 have been amended to recite a “laminator” in order to make the language of the claims more explicit. With this modification, Applicants respectfully assert that claims 1 and 14 are not indefinite and the 35 U.S.C. § 112, second paragraph rejection has been overcome.

Regarding the 35 U.S.C. § 112, second paragraph, rejection of claims 4 and 5, Applicants do not necessarily agree with the Examiner’s rejection, however Applicants have amended these claims in order to expedite prosecution. Specifically, Applicants have amended these claims to set forth that the apparatus is configured to use a specific type of adhesive. Applicants respectfully assert that, as amended, these claims do further limit claim 1 and that the 35 U.S.C. § 112, second paragraph rejection has been overcome. Applicants further

respectfully assert that the above noted amendment also overcomes the objection to these claims under 37 C.F.R. § 1.75(c) for the same reasons.

With respect to the claim 7 rejection under 35 U.S.C. § 112, second paragraph, Applicants do not necessarily agree with the Examiner's position, however Applicants have amended the claim in order to expedite prosecution. In this regard, Applicants have amended claim 1, from which claim 7 depends, to recite a laminator that is configured to superimpose. Thus, it is respectfully submitted that the questions that the Examiner raised with respect to claim 6 are now moot and the 35 U.S.C. § 112, second paragraph rejection is also moot.

With respect to the 35 U.S.C. § 112, second paragraph rejection of claims 9 and 13, claims 9-13 have been canceled. Thus, the 35 U.S.C. § 112, second paragraph rejection is now moot.

With respect to the 35 U.S.C. § 112, second paragraph, rejection of claim 15, Applicants do not necessarily agree with the Examiner's rejection, however Applicants have amended these claims in order to expedite prosecution. In this regard claim 15 has been amended to recite a "superimposing" in order to make the claim more consistent. With this modification, Applicants respectfully assert that claim 15 is not indefinite and the 35 U.S.C. § 112, second paragraph rejection has been overcome.

The Examiner has rejected claims 1-5, 7, 14-16, and 18 under 35 U.S.C. § 103(a) as being unpatentable over European Patent No. EP 706178 in view of U.S. Patent 5,227,213 to KOMORI et al. and Applicant's admitted prior art or

Japanese Patent No. JP 60-125212. Next, the Examiner has rejected claims 2-3, 14, 16, and 18 under 35 U.S.C. § 103(a) as being unpatentable over EP 706178 in view of KOMORI et al. and Applicant's admitted prior art or JP 60-125212 and further in view of U.S. Patent No. 5,518,569 to ACHILLES et al. and U.S. Patent No. 4,850,425 to ANDERSON. The Examiner has then rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over European Patent No. EP 706178 in view of KOMORI et al. and Applicant's admitted prior art or JP 60-125212 and further in view ACHILLES et al. Next, the Examiner has rejected claims 7, 8, and 12 under 35 U.S.C. § 103(a) as being unpatentable over EP 706178, in view of KOMORI et al., and Applicant's admitted prior art or JP 60-125212 and further in view of Japanese Patent No. JP 5-20713 and Japanese Patent No. JP 8-36786. Thereafter, the Examiner has rejected claims 9 and 13 under 35 U.S.C. § 103(a) as being unpatentable over EP 706178, in view of KOMORI et al., and Applicant's admitted prior art or JP 60-125212 and further in view of JP 5-20713, JP 8-36786, and Japanese Patent No. 4-139630. The Examiner has rejected claims 10 and 11 under 35 U.S.C. § 103(a) as being unpatentable over EP 706178, KOMORI et al., Applicant's admitted prior art or JP 60-125212, JP 5-20713, JP 8-36786, and JP 4-139630 and further in view Japanese Patent No. JP 4-57234, and Japanese Patent No. JP 61-292242. Finally, the Examiner has rejected claims 19 and 20 under 35 U.S.C. § 103(a) as being unpatentable over European Patent No. EP 706178 in view of KOMORI et al. and Applicant's admitted prior art or JP 60-125212 and

further in view JP 4-57234, and JP 61-292242. Applicants respectfully traverse and assert that the rejections are inappropriate.

With respect to the Examiner's rejection of independent claims 1, 14, and 15, Applicants submit that the Examiner is incorrect in the assertion that it would have been obvious to use an adhesive source at a temperature T1 and a defoaming tank at a higher temperature T2.

To the contrary, there appears to be no disclosure whatsoever in EP 706178, KOMORI et al., Applicant's admitted prior art, or JP 60-125212 with respect to the relative temperatures of either the defoaming tank or the adhesive source.

Moreover, there is no suggestion or disclosure in EP 706178, KOMORI et al., Applicant's admitted prior art, or JP 60-125212 separately or in any proper combination that render obvious the relative temperatures of the defoaming tank and the adhesive source of the present claimed invention. In the present invention, the two respective temperatures control the amount and/or rate of spinning (see page 26, lines 1-19 of the specification) and control the time for filtering and defoaming (see the paragraph bridging pages 33-34).

A rejection under 35 U.S.C. § 103 based on obviousness cannot be properly maintained without a proper disclosure of each and every element and the motivation to combine and modify these elements to achieve the claimed invention. Here the applied references fail to provide any motivation that would lead one of ordinary skill in the art to modify the references to have the two

different temperatures. Accordingly, the Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. § 103.

With regard to dependent claims 2-5, 7, 9-11, 16, and 18, Applicant asserts that they are allowable on their own merit and at least because they depend on one of independent claims 1, 14, and 15, which Applicants submit have been shown to be allowable. Additionally, minor amendments have been made to claims 1, 2, 4, 5, 7, 9-11, 14 and 15 in order to make to them more consistent. In these amendments, Applicants have made several additional changes to the language of the claims to render the same more self consistent, as well as more fully in compliance with U.S. syntax, idiom and grammar. These amendments do not change the scope of the claims but are merely cosmetic changes that give rise to no file wrapper estoppel.

The Examiner has rejected claims 6 and 17 under the judicially created doctrine of obviousness-type double patenting over claims 5 and 16 of U.S. Patent No. 6,309,485. Next, the Examiner has provisionally rejected claims 8 and 12 under the judicially created doctrine of obviousness-type double patenting over claims 11-13 of copending application 09/887,082 in view of JP 5-20713. Next, the Examiner has provisionally rejected claims 9 and 13 under the judicially created doctrine of obviousness-type double patenting over claims 11-13 of copending application 09/887,082 in view of JP 5-20713 and JP 4-139630. Next, the Examiner has provisionally rejected claims 10 and 11 under the judicially created doctrine of obviousness-type double patenting over claims 11-13 of

copending application 09/887,082 in view of JP 5-20713, JP 4-139630, JP 4-57234, and JP 61-292242. Finally, the Examiner has provisionally rejected claims 10, 11, 19 and 20 under the judicially created doctrine of obviousness-type double patenting over claim 9-11 of copending application 09/887,083 in view of JP 5-20713.

Applicants do not necessarily agree with the Examiner's obviousness type double patenting rejections of the above-noted claims. Specifically, with respect to the obviousness-type double patenting and provisional obviousness-type double patenting rejections, 35 U.S.C. § 121, third sentence, prohibits obviousness-type double patenting rejections in a divisional application based on a patent that was a parent application that was subject to a restriction requirement. See MPEP section 804.01. Nevertheless, with respect to claims 6, 8-13, 17, 19, and 20, Applicants have canceled these claims in order to expedite prosecution.

In view of the fact that none of the art of record, whether considered alone or in any proper combination, discloses or suggests the present invention as defined by the pending claims, and in further view of the above remarks, reconsideration of the Examiner's action and allowance of the present application are respectfully requested and are believed to be appropriate.

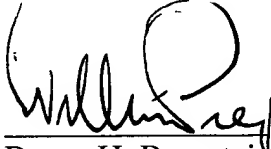
SUMMARY AND CONCLUSION

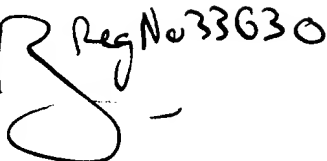
Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so. Applicants have pointed out the specific language of Applicants' claims that define over the references of record and respectfully request an indication to such effect, in due course.

The amendments to the claims made in this amendment have not been made to overcome the prior art, and thus, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions, please contact the undersigned at the telephone number provided below.

Respectfully submitted,
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